

U.S. PATENT APPLICATION SERIAL NO. 10/058,175
ATTORNEY DOCKET NO. 53470.009005

REMARKS/ARGUMENTS

The application has been amended to more clearly describe the present inventions. The pending and amended claims overcome the rejections of claims 1-18 based on the applied references. Reconsideration is respectfully requested. No new matter has been added.

PENDING REJECTIONS AND OBJECTIONS

Claim 13 stands objected to for allegedly lacking antecedent basis and having a typographical error. Both issues have been addressed with this response without adding new matter. Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 1-12 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over the Motorola VoxML 1.1 Language Reference ("Motorola") in view of U.S. Patent No. 6,449,496 to Beith et al. ("Beith"). Claims 13-18 stand rejected under section 103(a) as being allegedly unpatentable over that combination and further in view of U.S. Patent No. 6,269,336 to Ladd et al. ("Ladd"). Applicants respectfully traverse these rejections.

REJECTIONS UNDER 35 U.S.C. § 103(a)

The Office Action fails in all of the above rejections to set forth a proper *prima facie* case of obviousness. While it recognizes that the Motorola references does not disclose or suggest a an n-best list element in an XML-based language structure as recited in the claims, the Office Action nevertheless asserts that modifying the Motorola reference to include such a feature would have been obvious "so that a VoxML developer that wanted to verify a user's response by presenting recognition results in an n-best list manner would easily be able to do so without having to develop their own method and corresponding VoxML code." Such a statement represents classic impermissible hindsight.

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First, the Office Action improperly *assumes* the combination recited in the claim would be desired. It says "a VoxML developer *that wanted to* verify a user's response by presenting recognition results in an n-best list manner" (emphasis added). The PTO has the burden to establish that the prior art taken as a whole suggests the desire or advantage. Here, the PTO has boldly assumed that a VoxML developer would want to verify a user's response using an n-best list manner. The PTO fails to explain why the art suggests that such a VoxML developer would want to use an n-best list manner. Its assumption is improper.

Second, the Office Action fails to provide any *evidence* (relying instead on the Examiner's own hindsight conjecture) as to why one of ordinary skill in the art would choose to implement the n-best list element in the way claimed. None of the references the Office Action cites state that there is an advantage in adding an element in the XML-based language. Apparently, the Office Action's statement that it would make it easier on the VoxML developer is wholly unsupported. The Office Action's modification of Motorola and Beith in view of Ladd suffers from similar flaws. Absent further evidence, the Office has failed to meet its *prima facie* burden.

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CONCLUSION

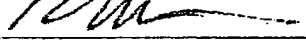
Since the cited references, taken either singly or in combination, fail to teach or suggest the combinations set forth in the pending claims, and further fail to provide any motivation or suggestion of the desirability of modifying the structures or methods to arrive at the claimed combinations, Applicants submit that the pending claims are allowable over the cited references. Accordingly, Applicants respectfully request that the Examiner withdraw his rejections, allow the pending claims and pass the application to issue.

If the Examiner believes that a telephone conference or interview would advance prosecution of this application in any manner, the undersigned stands ready to conduct such a conference at the convenience of the Examiner.

If there are any fees due under 37 C.F.R. §1.116 or §1.117 which are not enclosed herewith, including any fees required for extension of time under 37 C.F.R. §1.136, please charge such fees to our Deposit Account No. 50-0206.

Respectfully submitted,

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